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OFFICE OF PETITIONS

In re Application of
Voellmicke, et al.
Application No. 09/784,383
Filed: February 15, 2001
Attorney Docket No. DEP0468

DECISION ON PETITION

This is a decision on the "Petition Under 37 CFR 1.183 for Suspension of Rules" filed October 11, 2001 (certificate of mailing October 5, 2001), requesting that applicants' preliminary amendment be accorded a filing date of September 14, 2001. This is properly treated as a request that the amendment be afforded the benefit of timely filing under \$1.8.

The above-identified application has been accorded a filing date of February 15, 2001. On October 11, 2001, the instant preliminary amendment was received in the Office. The application has yet to be forwarded to an examiner for consideration.

Petitioner asserts that the preliminary amendment and postcard were mailed in an envelope addressed to Assistant Commissioner of Patents on September 14, 2001 with a Certificate of Mailing in compliance with 37 CFR 1.8(a) in order to obtain a filing date of September 14, 2001. However, the USPS misdelivered the envelope; the petitioner received it at the return address on the envelope on October 1, 2001. (The USPS returned the correspondence to petitioner rather than delivering it to addressee U.S. Patent and Trademark Office.) Petitioner requests that the paper be accorded a filing date of September 14, 2001. In support thereof, petitioner submitted *inter alia* a copy of the correspondence as originally mailed, bearing a certificate of mailing signed September 14, 2001; and a declaration of administrative assistant Karen Day, attesting to mailing the correspondence on September 14, 2001.

RELEVANT REGULATIONS AND RULES OF PRACTICE

§ 1.6 Receipt of correspondence.

(a) Date of receipt and Express Mail date of deposit.
Correspondence received in the Patent and Trademark Office is stamped with the date of receipt except as follows:

(1) The Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for correspondence transmitted by facsimile under paragraph (a)(3) of this section, or filed electronically under paragraph (a)(4) of this section, no correspondence is received in the Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.

(2) Correspondence filed in accordance with \$1.10 will be

stamped with the date of deposit as "Express Mail" with the United States Postal Service.

(3) Correspondence transmitted by facsimile to the Patent and Trademark Office will be stamped with the date on which the complete transmission is received in the Patent and Trademark Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.

§ 1.8 Certificate of mailing or transmission.

(a) Except in the cases enumerated in paragraph (a)(2) of this section, correspondence required to be filed in the Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

(1) Correspondence will be considered as being timely filed if:

(i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:

(A) Addressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail; or

(ii) and (iii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission.

MPEP 512 clarifies that the use of the certification procedure set forth in §1.8, does not change the receipt date under §1.6:

... The Office will continue its normal practice of stamping the date of receipt ("Office Date" Stamp) on all papers received through the mail or by facsimile except those filed under 37 CFR 1.10 (See MPEP § 513). The date stamped will also be the date which is entered on Office records and from which any subsequent periods are calculated. For example, 37 CFR 1.192 gives an appellant 2 months from the date of the appeal to file an appeal brief. For example, if the last day to reply to a final rejection was November 10, 1997, and applicant deposited a Notice of Appeal with fee in the U.S. mail on November 10, 1997, and so certified, that appeal is timely even if it was not received in the U.S.

Patent and Trademark Office until November 16, 1997. Since the date of receipt will be used to calculate the time at which the brief is due, the brief will be due on January 16, 1998. This is 2 months after the Mail Center date.

§ 1.115 Preliminary amendments.

(a) A preliminary amendment is an amendment that is received in the Office (§1.6) on or before the mail date of the first Office action under §1.104.

(b)(1) A preliminary amendment will be entered unless disapproved by the Commissioner. A preliminary amendment may be disapproved if the preliminary amendment unduly interferes with the preparation of a first Office action in an application. Factors that will be considered in disapproving a preliminary amendment include:

- (i) The state of preparation of a first Office action as of the date of receipt (§1.6) of the preliminary amendment by the Office; and
- (ii) The nature of any changes to the specification or claims that would result from entry of the preliminary amendment.

(2) A preliminary amendment will not be disapproved if it is filed no later than:

- (i) Three months from the filing date of an application under § 1.53(b);
- (ii) The filing date of a continued prosecution application under § 1.53(d);
- or
- (iii) Three months from the date the national stage is entered as set forth in §1.491 in an international application.

(c) The time periods specified in paragraph (b)(2) of this section are not extendable.

§1.183 Suspension of rules.

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in §1.17(h).

ANALYSIS

Justice does not require waiver of the rules. Petitioner has shown that the amendment was originally mailed pursuant to §1.8 with a certificate of mailing date of September 14, 2001. This certificate of mailing date is of record in the application, and will be considered in evaluating the preliminary amendment. However, this date does not appear to be of any consequence to that evaluation. The instant preliminary amendment was not filed as a response to an Office action, and thus, consideration of the September 14, 2001 date is not necessary to find the amendment timely filed. The amendment was filed well past the three month period under §1.115(b)(2) for automatically not being disapproved. The application has yet to be forwarded to the examiner for preparation of a first Office action.

Thus, petitioner has shown no prejudice to this application in following the normal procedure under §1.6 of date stamping the paper, and entering on the jacket of the application, the

preliminary amendment as received October 11, 2001. In the event that applicant suffers such prejudice, then a petition should be filed. If that time comes, petitioner may wish to consider including a copy of this decision with that petition.

CONCLUSION

The petition is **DISMISSED AS MOOT**.

The response to the "Notice to File Missing Parts of Nonprovisional Application" filed October 15, 2001, is acknowledged.

The application file is being forwarded to the examiner for examination in due course, including consideration of the preliminary amendment filed October 11, 2001 (certificate of mailing September 14, 2001).

Telephone inquiries regarding this decision should be directed to Petitions Attorney Nancy Johnson at (703) 305-0309.



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